AF/3711

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Mark Yoseloff	Examiner:	V. Mendiratta
Serial No.	09/520,402	Group Art Unit:	3711
Filed:	March 8, 2000	Docket No.	PA0437.ap.US
Title:	POKER GAME WITH PARLAY BET		

MAIL STOP: APPEAL BRIEF PATENTS
P.O. BOX 2003
Commissioner for Patents
Alexandria, VA 22313-1450

The following documents are hereby submitted:

- ☒ Reply Brief to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office (three copies. 11 pages)
- ☒ Authorization to withdraw $140.00 to cover Personal Appearance Fee of a small entity.
- ☒ Transmittal Sheet
- ☒ Return postcard

Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers if an additional extension of time is deemed necessary by the Office. Authorization is hereby given to charge Deposit Account Number 50-1391 if such additional extension is necessary.

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By: _____
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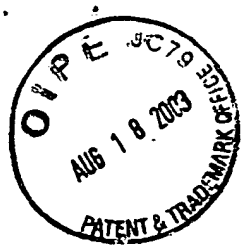
CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: MAIL STOP: APPEAL BRIEF – PATENT, P.O. BOX 1450, Commissioner for Patents, Alexandria, VA 22313-1450 August 13, 2002.

Mark A. Litman
Name

_____
Signature

Entered 8-26-03

#26/REPLY BRIEF



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REPLY BRIEF TO THE BOARD OF PATENT APPEALS AND INTERFERENCES OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

MAIL STOP: APPEAL BRIEF – PATENTS
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Sir:

This is a Reply Brief in an appeal from the Office Action mailed on November 4, 2003 finally rejecting claims 1-37, all the claims in the Application, and the Examiner's Answer mailed 29 July 2003. This Reply Brief is being filed in response to new issues and new arguments raised in the Examiner's Answer, for the first time on this Record.

This Reply Brief Includes authorization to debit **$140.00 (Small Entity Fee)** to Deposit Account No. 50-1391 to cover the fee for a Personal Appearance originally requested in the Brief and now due in response to the Examiner's Answer, or whatever fee is presently required. Appellants formally request the opportunity for a personal appearance before the Board of Appeals to argue the issues of this appeal. The fee for the personal appearance is now timely paid upon receipt of the Examiner's Answer.

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: MAIL TOP: APPEAL BRIEF – PATENT, P.O. BOX 1450, Commissioner for Patents, Alexandria, VA 22313-1450 on August 13, 2003.

Mark A. Litman
Name

Signature

STATUS OF CLAIMS

All claims in the Application have been finally rejected as follows:

1) Claims 1-19 and 22-37 have been finally rejected under 35 U.S.C. 103(a) as unpatentable over Williams in view of Ornstein ('885).
2) Claim 20 has been finally rejected under 35 U.S.C. 103(a) as unpatentable over Netley in view of Ornstein.
3) Claims 1, 4, 15, 20, 23 and 31 have been finally rejected under the Judicially Created Doctrine of Obviousness-Type Double patenting.

ISSUES ON APPEAL

The generic issues on Appeal are whether all claims in this Application directed to the invention are obvious under 35 USC 103(a); and whether claims 1, 4, 15, 20, 23 and 31 are directed to subject matter properly rejected under the Judicially-Created Doctrine of Obviousness-Type Double Patenting.

The specific issues in the Appeal under 35 U.S.C. 103(a) include at least:

a) The sequence of steps recited in the claims on appeal cannot be obvious when individual steps in the combination are not taught by any reference in the combination of references under 35 U.S.C. 103(a).

b) When the sequence of steps in the claims on appeal excludes a step that is essential to practice of the prior art, the claimed invention cannot be obvious under 35 U.S.C. 103(a) since amending the prior art would destroy essential elements of that invention.

The specific issues in the Appeal under the Judicially-Created Doctrine of Obviousness-Type Double Patenting include at least:

a) When the prior art added to the claims of the parent application of the Application on Appeal fails to teach difference between the claims of the parent application and the claims on Appeal, the rejection under this doctrine must fail.

GROUPING OF CLAIMS

The following grouping of claims remains the same as was set forth in the Brief on Appeal and has been made in compliance with the requirements of 37 C.F.R. 1.191 for the content of an Appeal Brief.

ARGUMENTS OF APPELLANT - RESPONSE TO THE REJECTIONS

Rejections Under The Judicially Created Doctrine of Obviousness-Type Double Patenting over (Unspecified) Claims of U.S. Patent No. 6,179,711 in view of Ornstein

There was a typographic error in the Brief in which the relevant Patent No. was mistyped in the heading. The substance of the response was accurately directed against and referred to the correct U.S. patent No. 6,179,711 as follows:

Claims 1, 4, 15, 20, 23 and 31 have been rejected under a purported Judicially Created Doctrine of Double Patenting over the claims of U.S. Patent No. 6,179,711 in view of Ornstein. Appellants have offered to provide a Terminal Disclaimer, and that offer remains in the application. However, the rejection itself is in error and must be reversed.

Claims 1, 4 and 10 shall stand or fall with the patentability of claim 1 on this issue

Claim 1 of U.S. Patent No. 6,179,711 is:

1. A method of scoring a video wagering game, the game comprising at least a first and second segment, the method comprising the steps of:

placing a wager to participate in a video wagering game;

playing the first segment of the video wagering game;

continuing play of the first segment until at least one predetermined condition has been met;

assigning a payout based on at least one winning outcome of the first segment;

playing the second segment of the video wagering game when the at least one predetermined condition has been met;

wherein said payout of the first segment is enhanced by a factor determined by an outcome in the second segment, and wherein the factor is at least one;

multiplying the payout of the first segment by the factor determined in the second segment; and

paying the enhanced payout to the player.

This rejection is not understood, as the games recited in the present claims are quite distinct from the elements of the method recited in the claims of U.S. Patent No. 6,179,711. Significant elements of the Patent claim that are not present in the play of the present method (in any claims) are highlighted.

The highlighted portions are not present in the recited method because:

continuing play of the first segment until at least one predetermined condition has been met;

1) There is no predetermined condition that is a condition precedent for any additional play, as recited in the Patent claim.

playing the second segment of the video wagering game when the at least one predetermined condition has been met;

2) The second hand is always dealt and is always played in the presently claimed method. There is no condition precedent of "playing...when the at least predetermined condition has been met." The second set of symbols or the second game is always played.

wherein said payout of the first segment is enhanced by a factor determined by an outcome in the second segment, and wherein the factor is at least one;

3) The second game does not determine factors. The second game (e.g., the second set of symbols or second hand) is independently awarded on the basis of its rank according to the pay table. No factor is determined.

multiplying the payout of the first segment by the factor determined in the second segment;

4) There is no multiplication of the first award by a factor determined in the second game event. The first payout is not multiplied. That amount is paid out (resolved in step a) by itself. The other events are separately paid out.

It is absolutely clear that the two processes (of the patented claims and the present claims) do not overlap and that the differences are not made obvious by Ornstein. The present claims could not have been recited in the Patent, as the present claims are a

distinct invention not even within the generic scope of the claims of the Patent, and the subject matter of the present process was not disclosed in the specification of the patent.

The teachings of Ornstein, even as proffered by the rejection do not teach the differences between the claims of U.S. Patent No. 6,179,711. Ornstein is used to teach "...a method of playing a game where a payoff is made for consecutive winnings (col. 2, lines 17-21)." (Page 4 of Final Rejection mailed 4 November 2002) In addition, the play of U.S. Patent No. 6,179,711 is more distinct from the play of the present claims then is the "difference taught by Ornstein."

In particular, Ornstein is offered as teaching awards for consecutive wins, while claim 1 recites:

> "...resolving the at least one bet with respect to whether a) the first set of symbols exceeds a minimum rank in the payout table; b) the second set of symbols exceeds a minimum rank in the payout table; and c) both the first set of symbols and the second set of symbols exceed a minimum in the payout table."

This step is completely distinct from the claims of U.S. Patent No. 6,179,711 where winning in a first event brings up a distinct multiplier game. There is no win provided on each distinct play (steps a and b) and an additional win based on both hands exceeding a minimum rank on a pay table. The play in the claims of U.S. 6,179,711 is nearly irrelevant to the play recited in claims 1, 4, 15, 20, 23 and 31 in this Appeal. Therefore, any suggested modification purported to be obvious from the claims of this Patent Reference must radically alter the nature of play of this patent and must be motivated by specific details for specific purposes. Ornstein fails to do this.

Ornstein teaches play of a game **without ranks in the play of the various games** (craps, roulette, and baccarat) where a player places two bets and receives a single hand. One bet is on the underlying game, and the second bet is on consecutive wins (not

contemporaneous hands with minimum ranks set out on pay tables). If the underlying bet is won, that bet is paid off and the consecutive bet wager remains in play. The player must then make a separate bet on a separate game, and if the player then wins the second game, the player is paid for having consecutive wins. Although "poker" is incidentally mentioned (column 6, lines 32-37), there is no mention of exceeding minimum ranks. As all games mentioned are games played against the house, the weak statement of "poker" must be assumed to be equivalent in play to the other games and be played against the house (player's hand versus dealer's hand). There is no mention of rank.

Thus, it is difficult to even attempt to combine the claims of U.S. 6,179,711, which have nothing to do with consecutive wins except for establishing a multiplier in a second bonus event for wins in an underlying game (without a payout for the bonus that is distinct from the awarded multiplier) with the play of Ornstein. The association proposed in the rejection has no motivation, and even if literally combined, the combination does not practice the subject matter of claim 1.

Additionally, all of these claims recite a limitation equivalent to:

"...without having placed an additional bet to the at least one bet;..."

This step is completely distinct from the required play of Ornstein which, by the very nature of the wagers being placed on consecutive games, requires that wagers be placed consecutively, and not have a single wager bet (even in a number of parts) during the entirety of the game.

To combine the two references (the claims of U.S. Patent No. 6,179,711) and Ornstein to assert obviousness of these claims, it becomes necessary to destroy the underlying play of each of the games and distort the combined parts of the two different game formats into something that resembles neither. This combination cannot establish obviousness under any doctrine. The rejection is in error and must be reversed.

Rejections Under 35 USC 103(a)

The Supplemental Examiner's Answer makes new assumptions, presumptions and the Answer borders on taking Official Notice with respect to the following issues quoted from the Supplemental Examiner's Answer.

A) The Supplemental Examiner's Answer (SEA) asserts that "Applicants may argue that hands 40 and 50 [in the present Application] are not consecutive hands."

That position taken by Appellants throughout the proceeding is that the hands are played contemporaneously. There is no assertion that the interpretation is in error, there is no assertion that the interpretation is met by the references, and in fact the rejection asserts that an event other than the limitations in the claims is obvious.

The interpretation is that the hands are not consecutive, but that the two hands are played contemporaneously. Note that claim 1 (and every other claim) has the limitation:

> "...resolving the at least one bet with respect to whether a) the first set of symbols exceeds a minimum rank in the payout table; b) the second set of symbols exceeds a minimum rank in the payout table; and c) both the first set of symbols and the second set of symbols exceed a minimum in the payout table."

This requires that both hands be shown, both hands be considered, and both hands be resolved at the same time. The claim requires that only after play of the first and second hands are a), b) and c) performed. That is not consecutive, but it is contemporaneous. The rejection therefore asserts that it:

> "One of ordinary skill in the art at the time the invention was made would have made the game more attractive for players by making an additional payoff for winning two or more plays consecutively." (Page 6, lines 14-17)

The Rejection therefore asserts to be obvious a practice that is not recited in the claims and is different from what is recited in the claims. The Rejection acknowledges this position by stating "Applicant might argue that hands 40 and 50 are not consecutive hands." The Rejection then ignores that clear and only interpretation of the claim language and rejects the claims as if the hands were consecutive. The rejection is therefore clearly in error on its face and must be reversed.

This is the first time that this issue has been raised in the Prosecution History of this Application and the Reply Brief is appropriate to respond to this new and erroneous basis of rejection.

CONCLUSION

All rejections of record have been shown in detail to be in error. All arguments (with the correction of the typographic error in the Patent No., are still retained by Appellants. The rejections should be reversed and all claims should be indicated as allowable.

Applicants believe the claims are in condition for allowance and request reconsideration of the application and allowance of the claims. The Examiner is invited to telephone the below-signed attorney at 952-832-9090 to discuss any questions that may remain with respect to the present application.

Respectfully submitted,
MARK L. YOSELOFF

By his Representatives,
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Date 13 August 2003 By 
Mark A. Litman
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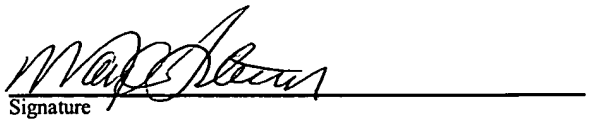
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Box AF, Assistant Commissioner of Patents, Washington, D.C. 20231 on **August 13, 2003**.

Name: Mark A. Litman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